

R E M A R K S

Favorable reconsideration is respectfully requested in view of the preceding amendments and following comments. By this Amendment claims 1, 12, 14 and 16 have been amended. Claims 1 to 8 and 10 to 19 are pending in the application.

Filed separately herewith is a Credit Card Payment Form PTO-2038 in the amount of \$1156.00 which includes \$980.00 for a three-month Petition for Extension of Time (also filed separately herewith) and \$176.00 for two additional independent claims over 3. If the amount is in error, the Patent and Trademark Office is authorized to debit or credit, as appropriate, Deposit Account No. 06-1358.

The rejection of claims 3 and 18 "under 35 U.S.C. 112, first paragraph" is respectfully traversed. As claims 3 and 18 are both composition claims and are not directed to a "method of stopping the loss of hair", the ground of rejection does not apply to these claims. In the event that the rejection of claims 13 to 16 was intended for this ground of rejection, those claims are no longer directed to "stopping the loss of hair", which was the basis for the issue involved. In any event, the ground of rejection has thus been completely overcome.

Applicants respectfully submit that prostaglandin EP-3 receptor antagonists comprise a recognized and understood group to one of at least ordinary skill in the art. Claim 3 is a combination claim, and the nature of the combination is such as would be readily understood by any artisan without any undue experimentation.

The rejection of claims 1, 2, 4, 5, 10 to 12, 15 and 18 "under 35 U.S.C. 102(a) and (3) as being anticipated by Cameron et al. . . ." is also respectfully traversed. Cameron does not disclose

the cosmetic composition, such a composition having a pH as currently specified in amended claim 1, or having an additive with regard to which claim 1 currently includes.

Cameron also fails to disclose the method called for by Applicants' claim 15.

The rejection of claims 6 to 8, 13 to 16 and 19 "under 35 U.S.C. 103(a) as being unpatentable over Carmen . . . and further in view of Deckers et al. . . ." is also respectfully traversed. "The factual inquiry whether to combine references must be thorough and searching." It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential component of an obviousness holding". *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). "Our case law makes it clear that the best defense against the subtle but powerful attraction of a hindsight based obvious analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dance*, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998). As clearly stated by the Federal Circuit in its opinion for *In re Lee*, 61 U.S.P.Q.2d 1430, at 1433: the essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 U.S.P.Q. 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relative to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.

Even if the compositions of Cameron could be used as described by Deckers, nobody would combine these two teachings because Cameron teaches the use of EP2 receptor agonists for a

Serial No.: 09/917,236
Atty. Docket No.: P66892US0

pharmaceutical purpose and more specifically to augment bone mass and to treat skeletal disorders in mammals, Nobody would use this teaching, even combined with the teaching of Deckers, to reduce hair loss. The tissues bone and hair skin are totally different, and the mechanisms of hair growth are very specific.


With regard to claims 6 to 8, one of ordinary skill in the art would have no motivation either to consider Cameron for combination with Deckers or to combine respective teachings because the involved formulations are not otherwise the same. There is no reason to believe that a composition containing an EP2 receptor agonist would be stable and would maintain all of its properties when mixed with polyhydroxyalcohols, as taught by Deckers, who discloses compositions comprising oil bodies derived from plants and to be used on the skin.

The outstanding Office Action repeatedly refers to "Carmen". If a different reference is actually intended, the complete citation thereof is respectfully requested.

Having overcome all outstanding grounds of rejection, favorable action on the merits and is in order and respectfully solicited.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By:  Ref No 19007
for Harvey B. Jacobson, Jr.
Reg. No. 20,851

400 Seventh Street, N. W.
Washington, D.C. 20004
Telephone: (202) 638-6666
Date: November 4, 2004
HBJ:IMA:cwp
R:\AISEN\11-04\P66892US0 AMD